

ESTTA Tracking number: **ESTTA289060**

Filing date: **06/10/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

|         |  |             |               |
|---------|--|-------------|---------------|
| Name    | Platinum Community Bank, FSB                                       |             |               |
| Entity  | federally chartered savings bank                                   | Citizenship | United States |
| Address | 2915 W. Kirchoff Rd.<br>Rolling Meadows, IL 60008<br>UNITED STATES |             |               |

|                      |  |
|----------------------|--|
| Attorney information | Jeffrey B. Sladkus, Esq.<br>Jeffrey B. Sladkus, LLC<br>1827 Powers Ferry Road Building 6, Suite 200<br>Atlanta, GA 30339<br>UNITED STATES<br>jeff@sladlaw.com Phone:404-252-0900 |
|----------------------|--|

### Registration Subject to Cancellation

|                 |   |                   |            |
|-----------------|---|-------------------|------------|
| Registration No | 3414489   | Registration date | 04/22/2008 |
| Registrant      | Platinum Bank<br>802 West Lumsden Road, Suite B<br>Brandon, FL 33511<br>UNITED STATES |                   |            |

### Goods/Services Subject to Cancellation


Class 036. First Use: 1997/08/01 First Use In Commerce: 1997/08/01  
All goods and services in the class are cancelled, namely: Banking services

### Grounds for Cancellation

|   |   |
|---|---|
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |
| Priority and likelihood of confusion            | Trademark Act section 2(d)                  |

### Mark Cited by Petitioner as Basis for Cancellation

|                      |                            |                       |            |
|----------------------|----------------------------|-----------------------|------------|
| U.S. Application No. | 77661274                   | Application Date      | 02/02/2009 |
| Registration Date    | NONE                       | Foreign Priority Date | NONE       |
| Word Mark            | PT PLATINUM COMMUNITY BANK |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         |    |
| Description of Mark | The mark consists of a stylized depiction of the letters Pt in between two vertical lines. A stylized depiction of the word Platinum appears to the right of the vertical lines. A stylized depiction of the words COMMUNITY BANK appears below the word Platinum. |
| Goods/Services      | Class 036. First use: First Use: 2008/10/31 First Use In Commerce: 2008/10/31 Banking and lending services   |
| Attachments         | 77661274#TMSN.jpeg ( 1 page )( bytes )<br>PLATINUM Cancellation.pdf ( 9 pages )(246592 bytes )   |

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                      |
|-----------|----------------------|
| Signature | /Jeffrey B. Sladkus/ |
| Name      | Jeffrey B. Sladkus   |
| Date      | 06/10/2009           |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

|                              |   |                        |
|------------------------------|---|------------------------|
| PLATINUM COMMUNITY BANK, FSB | ) |                        |
|                              | ) |                        |
| Petitioner,                  | ) |                        |
|                              | ) |                        |
| v.                           | ) | Cancellation No. _____ |
|                              | ) |                        |
| PLATINUM BANK                | ) |                        |
|                              | ) |                        |
| Registrant.                  | ) |                        |

**PETITION TO CANCEL**

Petitioner, Platinum Community Bank, FSB, a federally chartered savings bank ("Petitioner"), believes that it is being damaged by the continued registration of Registrant's PLATINUM BANK BB & design mark, U.S. Registration No. 3,414,489 (the "Registration"), and hereby petitions for cancellation of the Registration. As grounds for cancellation of the Registration, Petitioner respectfully alleges as follows:

1. Petitioner is a federally chartered savings bank with offices located at 2915 W. Kirchoff Rd., Rolling Meadows, Illinois 60008.
2. Platinum Bank, is a Florida corporation with offices located at 802 West Lumsden Road, Suite B, Brandon, Florida, 33511 ("Registrant").
3. The mark subject of this Petition to Cancel is a design word mark, PLATINUM BANK BB, as more specifically set forth below and in the Registration, registered on April 22, 2008 in International Class 36 for: "*Banking services*" (the "PBBB Mark"):



4. Petitioner has established extensive common law rights in the mark PLATINUM as used in connection with banking and lending services in multiple states.

5. Petitioner has filed with the U.S. Patent and Trademark Office (“USPTO”) an application to register its PT PLATINUM COMMUNITY BANK & design mark, which has been assigned U.S. Trademark Application Serial No. 77/661,274 (the “Application”) as more specifically depicted as follows:



6. Petitioner has used the mark PLATINUM since at least as early as 1999. Petitioner has been promoting and providing its banking and lending services for many years, and is currently promoting and providing its banking and lending services under the mark PT PLATINUM COMMUNITY BANK & Design in multiple states.

**Ground One for Cancellation**  
**Registration was Obtained Fraudulently**

7. Registrant is a Florida corporation providing banking services in certain counties within the State of Florida.

8. On September 28, 2007, Registrant filed an application to register the PBBB Mark alleging use dating back to 1997 and identifying “*banking services*” in International Class36. The application was assigned U.S. Trademark Application Serial No. 77/291339, and issued to registration on April 22, 2008 as U.S. Trademark Registration No. 3,414,489.

9. Upon information and belief, Registrant has not used the registered PBBB Mark “in commerce” as defined by Section 45 of the Trademark Act 15 U.S.C. §1127 (“Section 45 of the Lanhan Act”) because the Registrant only operates within the State of Florida and does not offer its banking services in other states.

10. On information and belief, Registrant has not used the registered PBBB Mark “in commerce” as defined by Section 45 of the Lanham Act because pursuant to federal banking laws, a banking institution must be licensed within the state upon which it operates to provide services to its customers within that specific state and, therefore, since Registrant is not operating any branches outside of the State of Florida, Petitioner alleges, on information and belief, that Registrant is not authorized by the federal banking commission to provide services outside the State of Florida. Therefore, Registrant cannot provide its banking services “in commerce” as defined by Section 45 of the Lanham Act.

11. In support of the foregoing, Registrant specifically states on Registrant’s website “About Us” page that their “Market Area” is principally Hillsborough and Polk counties (Florida) and the surrounding areas. Attached as **Exhibit A** is a copy from Registrant’s “About Us” page from its website.

12. As a result of Registrant’s conduct, PBBB either was aware, or should have been aware, that providing its services only within the State of Florida was not use of its PBBB Mark “in commerce” as defined by Section 45 of the Lanham Act.

13. Upon information and belief, such misrepresentations that the PBBB mark was used “in commerce” were material, were made with knowledge and intent and were false and misleading.

14. Accordingly, upon information and belief, Registrant made a fraudulent statement and oath in its application filed with the USPTO on September 28, 2007.

15. By reason of the foregoing, Petitioner will be damaged by the continued registration of Registrant’s PBBB Mark and, accordingly, the Registration should be cancelled.

**Ground Two for Cancellation**  
**Likelihood of Confusion Pursuant to Section 2(d) of the Lanham Act**

16. Registrant is a Florida corporation providing banking services in certain counties within the State of Florida.

17. Upon information and belief, Registrant only operates and is only licensed to operate in the State of Florida and does not offer its banking services in other states. Therefore, Registrant can only claim rights to its PBBB Mark in the State of Florida, and more specifically to limited geographic areas in which it operates.

18. Petitioner has used the mark PLATINUM in association with banking services since at least as early as 1999, and was operating in interstate commerce since well prior to the filing of Registrant’s Application Serial No. 77/291,339 - which was filed on September 28, 2007 (the “PBBB Application”).

19. Petitioner is the owner of its pending Application, as well as its extensive common law rights in the mark PLATINUM.

20. Petitioner has been providing its banking and lending services in connection with its PLATINUM mark well-prior to the filing date of the Registrant’s PBBB Application.

21. Since well prior to the filing date of Registrant's PBBB Application, Petitioner has, and is now, engaged in advertising, marketing, and promoting its banking and lending services under the mark PLATINUM in various states.

22. Through such promotion and marketing of Petitioner's banking and lending services, the mark PLATINUM has come to be associated with Petitioner, and distinguishes Petitioner's banking and lending services from the goods and services of others.

23. Moreover, through such promotion and marketing of Petitioner's banking and lending services under the mark PLATINUM, relevant customers, as well as the general public, have come to know and associate Petitioner's banking and lending services with the mark PLATINUM.

24. Petitioner will rely herein on its USPTO Application Serial No. 77/661274, as well as its U.S. common law rights in the mark PLATINUM.

25. The mark sought to be cancelled by Petitioner is confusingly similar to, Petitioner's PLATINUM mark.

26. The services identified in the Registration are commercially related to the Petitioner's banking and lending services marketed and provided by Petitioner under its PLATINUM mark.

27. Continued registration and/or use of Registrant's mark covered by the Registration: (i) is likely to cause confusion, mistake, and will deceive the general public as to the origin, sponsorship, and association of Registrant's wholly local services with Petitioner's services provided in several states under its mark; (ii) will mislead the general purchasing public into believing that Registrant's services are provided by, emanate from, or are in some way, directly or indirectly, associated with Petitioner, all to the damage and detriment of Petitioner.

28. If Registrant's Registration is permitted to continue in force maintaining Registrant's rights as conferred under the Principal Register of the Trademark Act of 1946, Registrant will unlawfully gain an advantage to which it is not entitled under the Trademark Act of 1946, to the detriment and harm of Petitioner.

29. By reason of the foregoing, Petitioner will be damaged by the continued registration of Registrant's Registration and, accordingly, the Registration should be cancelled.

**WHEREFORE**, Petitioner, believes and alleges that it will be damaged by continued registration of Registration No. 3,414,489 and prays that the present cancellation proceeding be sustained and judgment be entered in favor of Petitioner cancelling Registration No. 3,414,489.

The cancellation fee of \$300.00 is submitted herewith.

DATED this 10<sup>th</sup> day of June, 2009.

Respectfully submitted,

PLATINUM COMMUNITY BANK, FSB.



By: \_\_\_\_\_

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Attorney for Petitioner



CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the Petition to Cancel was deposited with United States Postal Service on June 10, 2009 by first class postage prepaid air mail addressed to:

Mary Ann Stiles, Esq.  
Stiles, Taylor & Grace  
P.O. Box 460  
Tampa, FL 33601



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Jeffrey B. Sladkus

Dated:            June 10, 2009  
                      Atlanta, Georgia

## **Exhibit A**



- ☒ **Personal Online Banking**
- ☐ Online Business Banking
- ☐ Online Premier Business Banking

Access ID: 

Logging in to our Internet Banking System is for authorized purposes only. Unauthorized access or use is strictly prohibited. Activity on this site is monitored for security purposes.

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## About Us - Our Bank

### [Our People](#)

#### **Our Bank**

Platinum Bank™ commenced banking operations in December 1997. It is our mission to provide high quality financial products with personalized customer service. We conduct business at these locations: our Main Office at 802 West Lumsden Road in Brandon; our Polk County Offices at 5404 South Florida Avenue and 724 South Florida Avenue in Lakeland; our Tampa Office at 408 South MacDill Avenue, Tampa, Plant City Office at 1804 James L Redman Parkway in Plant City and our newest location at 1285 First Street South in Winter Haven.

#### **Our Strategy**

The Bank's business strategy is to cater to consumers, professionals, small businesses, developers and commercial real estate investors by offering quality, personalized financial services which have become less available due to consolidation in the banking industry. We also seek to build our deposit base and loan portfolio through service-oriented relationship banking.

#### **Our Market Area**

Our primary market area consists principally of Hillsborough and Polk counties and surrounding areas.

**LOCAL OWNERS. LOCAL DECISIONS.**



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